

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Takashi TSUKAMOTO *et al.*

Appln. No.: 10/500,319

Filed: November 22, 2004

Patent No.: 7,148,250

Issued: December 12, 2006

Art Unit: 1626

Examiner: Nyeemah GRAZIER

Atty. Docket: 20595.128

Confirmation No.: 9108

For: *Indoles as NAALADase
Inhibitors*

Application for Patent Term Adjustment

Mail Stop - Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the patent term adjustment (“PTA”) as specified in the Issue Notification - Determination of Patent Term Extension under 35 U.S.C. §154(b), mailed on November 22, 2006 and on the issued patent. Applicants herein apply for an extension of the patent term beyond what was calculated by the U.S. Patent and Trademark Office (“Office”). The Issue Notification specified a PTA of 83 days (changed from the previous determination of 158 days). Applicants respectfully request that the Office reinstate 40 days of patent term reduced pursuant to 37 C.F.R. § 1.704(b), thereby according this application a PTA of 123 days.

In support of this application, Applicants set forth the following Statement of Facts.

Statement of Facts

1. On June 28, 2004, the instant application was filed. Included in the initial filing was an Information Disclosure Statement ("IDS"), along with a Form PTO/SB/08 and the associated references.
2. On October 15, 2004, a Supplemental IDS was filed, along with a Form PTO/SB/08 and the associated references.
3. On June 29, 2006, the Patent Office issued its first action - a notice of allowance. The Action stated that the IDS's filed on June 28, 2004 and October 15, 2004 had been fully considered by the Examiner. According to 37 C.F.R. §1.702(a)(2), the patent term is adjusted by 158 days due to Office delay.
4. On June 29, 2006, the Patent Office also issued a Determination of PTA which stated that the PTA to date was 158 days.
5. On September 29, 2006, Applicants filed an Amendment under Rule 312.
6. On November 2, 2006, the Examiner mailed a response disapproving the 312 Amendment.
7. On November 22, 2006, the Patent Office issued an Issue Notification containing a Determination of PTA of 83 days.
8. The patent issuing from this application is not subject to a terminal disclaimer.

Remarks

According to 37 C.F.R. §1.702(a)(1), the term of an original patent shall be adjusted if the Office fails to mail a notice of allowance under 35 U.S.C. §151 within fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. §371. The Office correctly calculated the examination delay in this application (158 days), due to failure of the Office to respond within fourteen months to Applicants' filing under 35 U.S.C. §371. The Determination of PTA under 35 U.S.C. 154(b) mailed with the Notice of Allowance and Issue Fee(s) Due on June 29, 2006, correctly stated that the PTA at that time was 158 days.

According to 37 C.F.R. §1.704(c)(10), there will be a reduction of the PTA period if Applicants submit an amendment under 37 C.F.R. §1.312. The reduction would be the lesser of: (i) the number of days beginning on the date the amendment under 37 C.F.R. §1.312 was filed and ending on the mailing date of the Office Action or notice in response to the amendment under 37 C.F.R. §1.312; or (ii) four months. Applicants filed an Amendment under 37 C.F.R. §1.312 on September 29, 2006, and the Office mailed a response on November 2, 2006. Therefore, the reduction of PTA should be 35 days, which would result in a total PTA of 123 days (158 days minus 35 days). However, the Issue Notification - Determination of Patent Term Extension under 35 U.S.C. §154(b), mailed on November 22, 2006, specified a PTA of only 83 days.

A review of the patent term adjustments in PAIR shows that an additional 40 days were reduced from Applicants' PTA next to an entry for "Information Disclosure Statement (IDS) Filed" on September 29, 2006. Applicants note that no IDS was filed on September 29, 2006. In fact, the only two IDS's filed in this application were those filed on June 28, 2004 and October 15, 2004, both of which were fully considered by the Examiner according to the Notice of Allowance mailed on June 29, 2006.

Applicants respectfully request that the Office reinstate the 40 days of PTA, and accord the present patent with a PTA of 123 days.

Authorization to charge the \$200.00 fee under 37 CFR 1.18(e), and any additional fees due in conjunction with this filing, is given in the accompanying transmittal letter.

Respectfully submitted,

A handwritten signature in black ink that reads "Danielle Edwards". The script is cursive and fluid.

Danielle M. Edwards (Reg. No. 51,645)
Suet M. Chong (Reg. No. 38,104)

Date: February 9, 2007

ARNOLD & PORTER LLP
555 Twelfth Street, N.W.
Washington, D.C. 20004-1206
(202) 942-5000 telephone
(202) 942-5999 facsimile